

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Confirmation No.: 9814

Del Soldato *et al.*

Group Art Unit: Unknown

Application Serial No.: 10/501,335 ✓

Examiner: Unassigned

Filed: July 23, 2004

Attorney Docket No.: 026220-00048

For: New Corticosteroids

May 20, 2005

PETITION UNDER 37 C.F.R. §1.47

Mail Stop PETITIONS
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

06/16/2005 CSHOOT 00000001 012300 10501335
 Sale Ref: 00000002 DAH: 012300 10501335
 01 FC:1463 200.00 DA

Sir:

Pursuant to 37 C.F.R §1.47, the applicants respectfully petition the U.S. Patent and Trademark Office to accept the Oath/Declaration submitted herewith containing the signature of inventor Ennio ONGINI. The signature of Piero DEL SOLDATO is missing as he refuses to join in the application (Piero DEL SOLDATO is a non-signing inventor). Pursuant to 37 C.F.R. §1.47 and M.P.E.P. §409.03, the applicants include:

- 1) an affidavit by Italian attorney Maria Teresa Noro indicating that she sent the entire application (specification, claims, and drawings) along with a declaration to inventor Del Soldato twice requesting his signature on the declaration. On neither occasion did inventor Del Soldato return the signed declaration nor did he ever indicate that he was willing to participate in this application;
- 2) letters sent by Attorney Noro with English translations thereof;
- 3) copies of postal receipts; and
- 4) Certificate of Translation

Serial Number: 10501335
 DAH: 012300 Name/Number: 10501335
 FC: 9204 \$130.00 CR

05/24/2005 GFKY1 00000031 10501335

01 FC:1464
 02 FC:2617

130.00 OP
 65.00 OP

RPP/119349.1

The last know address of inventor Piero DEL SOLDATO, is:

Via Enrico Toti 22
Monza, MI 20052
ITALY

The applicants respectfully submit that they have made a *bona fide* attempt to comply with the provisions of 37 C.F.R. §1.47. The applicants respectfully request the Office of Petitions grant this petition and forward the file to the Office of Initial Patent Examination (OIPE) for further processing. If any questions or issues remain, the Office of Petitions is respectfully requested to contact the undersigned to help with their resolution.

The applicants include the Notification of Missing Requirements and a check for \$195.00 containing \$130.00, the petition fee under 37 C.F.R. §1.17(h), and \$65.00, the surcharge for the late oath/declaration. As this response is filed within two months of the Notification of Missing Requirements (dated April 11, 2005), the applicants believe that no additional fees are due. If this response is not timely filed, the applicants hereby petition for an appropriate extension of time. The Commissioner is authorized to charge any additional fees or credit any over-payments to Deposit Account No. 01-2300, referencing Attorney Docket No. 026220-00048.

Respectfully submitted,

ARENT FOX PLLC



Gautam Prakash, Ph.D.

Registration No.: 53,481

Direct Telephone No.: 202-857-6057

Customer No.: **004372**

1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5339

Telephone No.: 202-857-6000
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/GP

Avv. Maria Teresa Noro

*20122 Milano
Via Freguglia, 4
Tel. 02.550.111.99
Fax 02.55.16.969*

Spettabile
NicOx Research Institute S.r.l.
Giovanna Barchielli
Via Ariosto, 21
20091 - BRESSO
(Milano)

Milan, April 26th, 2005
RACCOMANDATA

AFFIDAVIT

I, the undersigned Maria Teresa Noro, lawyer, practising in Milan, Via Freguglia 4, state the following.

I have been requested by Nicox to assist it in its controversy against Mr. Piero Del Soldato, a shareholder of the company Nicox S.A. and employee of Nicox S.r.l. who was dismissed by letter dated April 2, 2004.

On April 6, 2004, Mr. Piero Del Soldato challenged his dismissal and enforced his alleged right to be granted certain sums as compensation for his being assigned to less qualified duties, as well as the bonus under Articles 23 and following of Royal Decree no. 1127/39 (the Italian Patent Law) on account of the inventions of which he has been designated inventor or co-inventor during his employment relationship and which remains the sole property of N.S.A. For this reason, in the past few months I have been in touch on a frequent basis with Mr. Fabrizio Conte of the Milan Bar, the lawyer who is assisting Mr. Piero Del Soldato in the above mentioned controversy.

On February 7, 2005 Nicox S.A.'s Legal Department asked me to have the following documents signed by Mr. Piero Del Soldato and returned to it:

- 1) ns. rif. HF 2557 entitled "NEW CORTICOSTEROIDS"- 4 documents:
Canada/Assignment; New Zealand/Request under Section 23 (3);
USA/Assignment and Declaration and a copy on the entire application (i.e. specification, including claims and drawings).

- 2) ns. rif. NP 0001 entitled "PROBUCOL DERIVATIVES"- 2 documents: USA/Assignment and Declaration and a copy on the entire application (i.e. specification, including claims and drawings).
- 3) ns. rif. HF 2596 entitled "DRUGS FOR THE ARTHRITIS TREATMENT"- 2 documents: USA/Assignment and Declaration and a copy on the entire application (i.e. specification, including claims and drawings).
- 4) ns. rif. HF 2615 entitled "DEOXYCHOLIC ACID DERIVATIVES FOR THE TREATMENT OF ACUTE DYSFUNCTIONS OF PORTAL AND HEPATIC VENOUS CIRCULATION"- 5 documents: Canda/Assignment; New Zealand/Request under Section 23 (3); USA/Assignment and Declaration; South Africa/Assignment and a copy on the entire application (i.e. specification, including claims and drawings).

On February 14, 2005 I sent a set of the above mentioned documents to Mr. Piero Del Soldato, at his domicile in Monza, Via Enrico Toti 22 under registered mail, with copy hand-delivered to his lawyer, asking Mr. Piero Del Soldato to return said documents to me duly signed in fifteen days or to notify in writing his explanations for not doing so. Notwithstanding the notices the postman left him, Mr. Del Soldato never collected the mail delivery from the post office at which it was being held and it was subsequently returned to our office.

On March 29, 2005 I sent another set of the above mentioned documents to Mr. Piero Del Soldato under registered mail, with copy to his lawyer, asking Mr. Piero Del Soldato to return said documents to me duly signed in ten days or to notify in writing his explanations for not doing so.

Mr. Piero Del Soldato never sent back to me these documents.

I enclose herewith copies of my letter dated February 14, 2005 together with the receipt of acceptance of registered mail, the printout obtained from the Poste Italiane (the Italian Post Office) website reporting the status of delivery and copy of the envelope that was returned to us by the Post Office; I also enclose the second one dated March 29, 2005 together with the related registered mail receipt and acknowledgement of receipt.

A copy of my passport is also enclosed.

Respectfully submitted,


(Avv. Maria Teresa Noro)

Certification of Translation

I, Chiara Giuliani, declare that I can understand, read, and speak fluently both English and Italian. I have translated the letters of Maria Teresa Noro, which were in Italian, and attest that the English translations are an accurate representation of the original documents.

Chiara Giuliani
Chiara Giuliani

Date: 5/19/05

Avv. Maria Teresa Noro

20122 Milano
Via Freguglia, 4
Tel. 02.550.111.99
Fax 02.55.16.369

Egregio Signor
Dott. Piero Del Soldato
Via Enrico Toti 22
20052 - MONZA

e, per conoscenza
RACCOMANDATA A MANO

Egregio Signor
Avvocato Fabrizio Conte
Via Freguglia 8/a
20122 - MILANO

Milano, 29 marzo 2005
RACCOMANDATA A.R.

Egregio dott. Del Soldato,

in nome e per conto della Nicox S.A., faccio seguito alla mia del 14 febbraio scorso per inviarLe una seconda volta la documentazione seguente, che La prego di sottoscrivere e di restituire al mio Studio entro 10 giorni dal ricevimento della presente:

- 1) ns. rif. HF 2557 dal titolo "NEW CORTICOSTEROIDS"- 4 documenti: Canada/Assignment; New Zealand/Request under Section 23 (3); USA/Assignment e Declaration e il testo del brevetto.
- 2) ns. rif. NP 0001 dal titolo "PROBUCOL DERIVATIVES"- 2 documenti: USA/Assignment e Declaration e il testo del brevetto.
- 3) ns. rif. HF 2596 dal titolo "DRUGS FOR THE ARTHRITIS TREATMENT"- 2 documenti: USA/Assignment e Declaration e il testo del brevetto.
- 4) ns. rif. HF 2615 dal titolo "DEOXYCHOLIC ACID DERIVATIVES FOR THE TREATMENT OF ACUTE DYSFUNCTIONS OF PORTAL AND HEPATIC VENOUS CIRCULATION"- 5 documenti: Canada/Assignment; New Zealand/Request under Section 23 (3); USA/Assignment e Declaration; South Africa/Assignment e il testo del brevetto.

Trasmetto copia di questa lettera anche al Suo legale, Avv. Fabrizio Conte, per sua informazione.

Rimango in attesa di Suo urgente riscontro e La saluto molto distintamente.

Avv. Maria Teresa Noro
(Avv. Maria Teresa Noro)

All.: come nel testo

Maria Teresa Noro, Esq.

2nd mailing

Mr. Piero del Soldato
Via Enrico Toti, 22
20052 – Monza

20122 Milan
via Freguglia, 4
tel. 0255011199
Fax 025516369

cc: hand delivered
Fabrizio Conte, Esq.
Via Freguglia 8/a
20122 Milan

Milan, March 29, 2005
Delivery with return receipt

Dear Mr. Del Soldato,

On behalf of Nicox S.A., and following my letter dated February 14, 2005, I am sending you for the second time the documents referenced below. Please sign them and return them to me within 10 days from the day you receive this letter.

- 1) Our Ref. HF 2557 entitled "New Corticosteroids" – 4 documents: Canada/ Assignment; New Zealand/ Request under Section 23 (3); USA/ Assignment and Declaration, and the text of the patent.
- 2) Our Ref. NP 0001 entitled "Probucol derivatives" – 2 documents: USA/Assignment and Declaration and the text of the patent.
- 3) Our Ref. HF 2596 entitled "Drugs For The Arthritis Treatment" – 2 documents: USA/ Assignment and Declaration and the text of the patent.
- 4) Our Ref. HF 2615 entitled "Deoxycholic Acid Derivatives For The Treatment Of Acute Dysfunctions Of Portal And Hepatic Venous Circulation" – 5 documents: Canada/ Assignment; New Zealand/ Request under Section 23(3); USA/Assignment and Declaration; South Africa/ Assignment and text of the patent.

I am also sending a copy of this letter to your attorney, Fabrizio Conte, for his review.

I am looking forward to your urgent response. Best Regards.

Encl. as indicated above

[signature]
(Maria Teresa Noro, Esq.)

Avv. Maria Teresa Noro

Egregio Signor
dott. Piero del Soldato
Via Enrico Toti 22
20052 - MONZA

*20122 Milano
Via Freguglia, 4
Tel. 02.550.111.99
Fax 02.55.16.369*

e, per conoscenza
RACCOMANDATA A MANO
Egregio Signor
Avvocato Fabrizio Conte
Via Freguglia 8/a
20122 - MILANO

Milano, 14 febbraio 2005
RACCOMANDATA A.R.

Egregio dott. Del Soldato,

Le invio la documentazione di cui in appresso trasmessami
dalla Nicox, la quale mi ha incaricato di contattarLa per richiederLe di sottoscriverla.

Si tratta, specificamente, della seguente documentazione:

- 1) ns. rif. HF 2557 dal titolo "NEW CORTICOSTEROIDS"- 4 documenti:
Canada/Assignment; New Zealand/Request under Section 23 (3);
USA/Assignment e Declaration e il testo del brevetto.
- 2) ns. rif. NP 0001 dal titolo "PROBUCOL DERIVATIVES"- 2 documenti:
USA/Assignment e Declaration e il testo del brevetto.
- 3) ns. rif. HF 2596 dal titolo "DRUGS FOR THE ARTHRITIS TREATMENT"- 2
documenti: USA/Assignment e Declaration e il testo del brevetto.
- 4) ns. rif. HF 2615 dal titolo "DEOXYCHOLIC ACID DERIVATIVES FOR THE
TREATMENT OF ACUTE DYSFUNCTIONS OF PORTAL AND HEPATIC
VENOUS CIRCULATION"- 5 documenti: Canda/Assignment; New
Zealand/Request under Section 23 (3); USA/Assignment e Declaration; South
Africa/Assignment e il testo del brevetto.

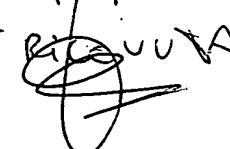
Le invio tale documentazione per la firma e attendo che Lei me la restituisca entro 15
giorni da oggi.

Trasmetto copia di questa lettera e dell'allegata documentazione anche al Suo legale,
Avv. Fabrizio Conte, affinché ne possa prendere visione.

Coi migliori saluti.


(Avv. Maria Teresa Noro)

All.: come nel testo

*15/2/05
X RICHIESTA*


Maria Teresa Noro, Esq.

1st mailing

Mr. Piero del Soldato
Via Enrico Toti, 22
20052 – Monza

20122 Milan
via Freguglia,4
tel. 0255011199
Fax 025516369

cc: hand delivered
Fabrizio Conte, Esq.
Via Freguglia 8/a
20122 Milan

Milan, February 14, 2005
Delivery with return receipt

Dear Mr. Del Soldato,

I am sending you the documents referenced below, sent to me by Nicox, which asked me to contact you and to request that you sign them.

Specifically, the documents are listed below:

- 1) Our Ref. HF 2557 entitled "New Corticosteroids" – 4 documents: Canada/ Assignment; New Zealand/ Request under Section 23 (3); USA/ Assignment and Declaration, and the text of the patent.
- 2) Our Ref. NP 0001 entitled "Probucol derivatives" – 2 documents: USA/Assignment and Declaration and the text of the patent.
- 3) Our Ref. HF 2596 entitled "Drugs For The Arthritis Treatment" – 2 documents: USA/ Assignment and Declaration and the text of the patent.
- 4) Our Ref. HF 2615 entitled "Deoxycholic Acid Derivatives For The Treatment Of Acute Dysfunctions Of Portal And Hepatic Venous Circulation" – 5 documents: Canada/ Assignment; New Zealand/ Request under Section 23(3); USA/Assignment and Declaration; South Africa/ Assignment and text of the patent.

I am sending these documents for your signature and I expect that you will send them back to me within 15 days from today.

I am also sending a copy of this letter and of the enclosed documents to your attorney, Fabrizio Conte, for his review.

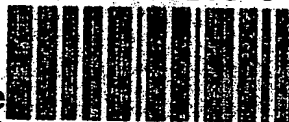
Best Regards.

Encl. as indicated above

[signature]
(Maria Teresa Noro, Esq.)

2/15/05
received [signature]

J5142085110-0



Posteitaliane

Mod. 22 - R - Cod. W8150E - Ed. 10/01 (00) L1

Accettazione: **RACCOMANDATA**

RICEVUTA

È vietato introdurre denaro e valori nelle raccomandate: Poste Italiane SpA non ne risponde

Si prega di compilare a cura del mittente a macchina o in stampatello

DESTINATARIO	DOT. PIERO DEL SODATO		
	ENRICO TORI		
	VIA / PIAZZA		
MITTENTE	20052	MONZA	22
	C.A.P.	COMUNE	N° CIV.
	PROV.		
MITTENTE	AUGUSTA TERESA NORD		
	FREGUGLIA		
	VIA / PIAZZA		
MITTENTE	20122	MILANO	6
	C.A.P.	COMUNE	N° CIV.
	PROV.		

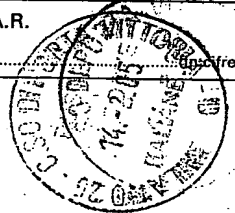
SERVIZI ACCESSORI
RICHIESTI

Contrasegnare la
casella interessata

☐ Via aerea

☒ A.R.

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Bollo

(accettazione manuale)

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Accettazione **RACCOMANDATA** usucqis

RICEVUTA

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Si prega di compilare a cura del mittente a macchina o in stampatello

DESTINATARIO	DOT. PIERO DEL SUDATO	
	DESTINATARIO	
	ENRICO TOI	
MITTENTE	VIA / PIAZZA	22
	20052 MONZA	N° CIV.
	C.A.P. COMUNE	PROV.
AW. MARIA TERESA NOTO		
Via Freguglia, 4 20122 MILANO		
Tel. 02-550.111.89 (r.a.)		
Fax 02-5516369		
C.A.P. COMUNE		PROV.

SERVIZI ACCESSORI
RICHIESTI

Contrassegnare la
casella interessata

☐ Via aerea

☒ A.R.

☐ Assegno €

(in cifre)



Bollo
(accettazione manuale)

2^a SEZIONE

Avviso di ricevimento

☒ Raccomandata ☐ Pacco

☐ Assicurata Euro _____

1 2 7 4 5 2 7 7 6 8 1 0

Numero

Data di spedizione 29 MARZO 2005 Dall'ufficio postale di MILANO 25

Destinatario DOT. PIERO DEL SOLNATO

Via ENRICO TON, 22

C.A.P. 20052 Località MONZA

Ed. 02/04 - (00) L1

Firma per esteso del ricevente
(Nome e Cognome)

Data

Firma dell'incaricato alla distribuzione

Bollo dell'ufficio
di distribuzione

☐ Consegna effettuata ai sensi dell'art. 33 D.M. 09.04.01:
• Invii multipli a un unico destinatario
• Sottoscrizione rifiutata